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UNITED STATES PATENT AND TRADEMARK OFFICE

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Schlumberger Technology Corporation  
IP Dept., Well Stimulation  
110 Schlumberger Drive, MD1  
Sugar Land, TX 77478

In re Application of JOHNSON<sup>1</sup> et al. :  
Application No.: 09/980,463 :  
PCT No.: PCT/EP99/03946 :  
Int. Filing: 03 June 1999 :  
Priority Date: None : DECISION ON PETITION  
Attorney Docket No.: 55.0206PCT : UNDER 37 CFR 1.47(a)  
For: SHEAR-SENSITIVE PLUGGING FLUID :  
FOR PLUGGING AND A METHOD FOR :  
PLUGGING A SUBTERRANEAN :  
FORMATION ZONE :

This is a decision on applicant's petition under 37 CFR 1.47(a) along with a request for a three month extension of time, filed in the United States Patent and Trademark Office (USPTO) on 17 June 2002. The petition fee and extension of time fees were paid.

### **BACKGROUND**

On 03 June 1999, applicant filed international application No. PCT/EP99/03946 which did not make a claim for priority. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 December 2000.

A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 January 2002.

On 29 November 2001, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 08 January 2002, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration of the inventors in compliance with

On 17 June 2002, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signatures of inventors, Kamal Arsanious and Allen R. Toney. Applicant alleges that Kamal Arsanious cannot be found and that Allen R. Toney has indicated he would sign the appropriate forms but has not done so. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicant, Les Johnson, David Quinn and Patrick Murphy on behalf of Kamal Arsanious and Allen R. Toney and a statement of facts under 37 CFR 1.47(a). Applicant also requested a three month extension of time, which is granted.

### DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the \$130 petition fee. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventors and satisfies the requirements of 37 CFR 1.47(a). Item (3) is satisfied because the last known addresses of non-signing inventors, Kamal Arsanious and Allen R. Toney was provided.

With respect to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

....

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

...A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

....

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, Petitioner submitted a statement of facts under 37 CFR 1.47(a) in the form of a letter signed by Carmen Delgado, dated 05 April 2002, with an attached summary of the actions she performed in an attempt to obtain the signatures of the inventors. Ms. Delgado's letter also references the letters and e-mails she sent to the inventors, which were attached. The letter to inventor Allen R. Toney indicates that assignment forms were sent to the inventor for his signature with no mention of a copy of application papers (specification, including claims, drawings, and oath or declaration) being sent to the nonsigning inventor for signature. In this instance, Mr. Toney signed for the delivered documents as indicated by the postal delivery notice included with the petition. Furthermore, Ms. Delgado states that Mr. Toney indicated to her that he will sign but has not actually responded to her request to sign the assignment. However, there is no indication that a copy of the declaration, along with a copy of the application including specification, claims and drawings, was mailed to Mr. Toney on February 12, 2002 at last known residence, requesting his signature. Under these circumstances, it cannot be concluded that Mr.

Toney refuses to sign the application or is uncooperative.

Likewise, Ms. Delgado's summary indicates that Kamal Arsanious' address has changed and his new address was not found. Ms. Delgado apparently sent "document forms" for this application to joint inventor Les Johnson, who could not forward them to Mr. Arsanious because his address was not known. However, no further attempts to locate Mr. Arsanious are enumerated so as to conclude that he cannot be found. This is insufficient evidence to conclude that applicant/inventor has refused to sign the application or cannot be located.

Petitioner should attempt to determine if the inventor left a forwarding address. There is no documentation that attempts to contact Mr. Arsanious at his last known e-mail address and last known telephone number were made. There were no attempts made using the telephone and the internet to locate Mr. Arsanious' and no inquiries made at Mr. Arsanious' last known place of employment and last known residence to ascertain his current address. Further attempts to contact Mr. Arsanious via telephone, E-mail, his place of employment, etc. should be tried and documented. The steps taken to locate the whereabouts of the nonsigning inventor should be included in a statement of facts. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts, listing the steps taken to locate the whereabouts of the nonsigning inventor. What is required is that Mr. Arsanious be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application as identified above.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. A diligent effort requires more than sending "document forms" to the joint inventor.

In sum, petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/980,463 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signatures, sent to their last known address and (2) Mr. Toney and Mr. Arsanious' refusal to sign, either in writing or by telephone, these documents, their uncooperativeness or their unavailability.


The evidence submitted does not support a finding that the nonsigning inventors refuse to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR §1.47(a) is DISMISSED WITHOUT PREJUDICE.

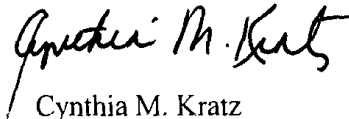
Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard E. Smith  
Legal Examiner  
PCT Legal Office

CMK/LES:cmk



Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office

Telephone: (703) 306-5467

**Kratz, Cynthia**

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**From:** Alexander, James  
**Sent:** Tuesday, April 15, 2003 2:27 PM  
**To:** Kratz, Cynthia  
**Cc:** McAskill, Mary Louise  
**Subject:** RE: 09/980,463

This will be in the 05-13-03 issue.

-----Original Message-----

**From:** Kratz, Cynthia  
**Sent:** Tuesday, April 15, 2003 2:26 PM  
**To:** Alexander, James  
**Cc:** McAskill, Mary Louise  
**Subject:** 09/980,463

Please publish this notice in the OG. Thanks,

Cynthia M. Kratz  
Attorney  
PCT Legal Office

703-306-5467

#### OFFICIAL GAZETTE NOTICE

#### 37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of a national stage application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Allen R. Toney) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/EP99/03946 and was filed on 03 June 1999 in the names of Les Johnson, Kamal Arsanious, David Quinn, Patrick Murphy, and Allen R. Toney for the invention entitled Shear-Sensitive Plugging Fluid for Plugging and A Method for Plugging a Subterranean Formation Zone. The national stage application is assigned number 09/980,463 and has a 35 U.S.C. 371(c) date of 11 December 2002.